

PATENT
App. Ser. No.: 10/600,021
Atty. Dkt. No. ROC920030230US1
PS Ref. No.: IBMK30230

IN THE DRAWINGS:

The attached sheets of drawings include changes to Fig. 3A and 8A.

Attachment:

Replacement Sheets for Fig. 3A and Fig. 8A.

Annotated Sheets Showing Changes to Fig. 3A and Fig. 8A.

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REMARKS

This is intended as a full and complete response to the Office Action dated February 13, 2006, having a shortened statutory period for response set to expire on May 15, 2006. Please reconsider the claims pending in the application for reasons discussed below.

In the specification, paragraph [0027] has been deleted. Paragraphs [0048], [0049], [0106], [0114] and [0115] have been amended to correct minor editorial problems.

Claims 1-37 are pending in the application. Claims 1-37 remain pending following entry of this response. Claims 15, 25 and 36 have been amended. Applicants submit that the amendments do not introduce new matter.

Claim Rejections - 35 U.S.C. § 101

Claims 25 and 26 are rejected under 35 U.S.C. § 101. The Examiner asserts claims 25 and 26 are directed to non-statutory subject matter. Applicants have amended independent claim 25 to address the concern raised by the Examiner. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Claim Rejections – Double Patenting

Claims 1, 2, 15, 25, and 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 12, 18 and 28 of Co-pending Application No. 10/600014.

The doctrine of obviousness-type double patenting has been interpreted by at least one court as: "[a] later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim." (*In re Longi*, 759 F.2d at 896, 225 USPQ at 651). The application cited by the examiner and the current application were both filed on June 20, 2003. Therefore, the claims in the current application are not "later patent claims", and thus cannot be rejected under the

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doctrine of obviousness-type double patenting. Thus, Applicants respectfully request the obviousness-type double patenting rejection be withdrawn.

Claim Rejections - 35 U.S.C. § 102

Claims 1-4, 6, 8-26, 30-37 rejected under 35 U.S.C. 102(e) as being anticipated by US patent No 6,956.593 to *Gupta* et al (hereinafter *Gupta*).

Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Gupta* does not disclose "each and every element as set forth in the claim". For example, *Gupta* does not disclose at least the claim limitations reciting "a set of annotation structures" as in claims 1, 15, 25, 28 and 30.

Gupta discloses a structure for an annotation entry with several different fields. (*Gupta*, Column: 7, Lines: 27-39). *Gupta* also discloses a graphical user interface (GUI) which may be used to create or view many annotations based on the one structure for an annotation entry. (*Gupta*, Column: 11, Lines: 60-65). In *Gupta* annotations are created by entering descriptive information into the GUI. (*Gupta*, Column: 12, Lines: 56-57).

The Examiner argues that *Gupta* discloses "a set of annotation structures" at Col 7 lines 27-30, Figure 4. However, the cited passage is in fact directed to a single structure for an annotation entry, and the elements which make up that single structure for an annotation entry. Nowhere in Gupta is "a set of annotation structures" described

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as recited in the present Claims, rather Gupta only discloses a single annotation structure.

Furthermore, nowhere in *Gupta* is "providing...one or more interfaces ... wherein the information presented in each interface is dependent on an associated one of the annotation structures" described as recited in the present claims, because only a single structure is provided. As discussed in the specification of the present application, different annotation structures give the ability to generate different interfaces such that different data objects may be annotated differently. As claimed, the annotation structure associated with a particular data object will determine the information presented in each interface. *Gupta*, on the other hand, only provides a single structure and thus only one type of interface with predetermined information can be created.

Thus, *Gupta* does not disclose at least the claim limitation of "a set of annotation structures", and the claim limitation of "providing...one or more interfaces...wherein the information presented in each interface is dependent on an associated one of the annotations structures. Therefore, independent claims 1, 15, 25, 28 and 30 and their dependents are believed to be allowable, and allowance of the claims is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 5, 7, 27, 28, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent No 6,956,593 to *Gupta* et al (hereinafter *Gupta*), in view of Pub No. US 2002/0184401 to *Kadel* JR et al (hereinafter *Kadel*).

Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second,

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there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the first and third criteria.

With respect to the first criteria, the proposed modification cannot render a reference unsatisfactory for its intended purpose. The MPEP states "it is improper to combine references where the references teach away from their combination." (MPEP, 2145(X)(D)). The Examiner argues that there is a suggestion or a motivation to combine the *Gupta* reference and the *Kadel* reference. However, Applicants submit that there is not a suggestion or motivation to combine the references, because *Kadel* teaches away from the reference of *Gupta*. The proposed modification of the *Gupta* reference with the *Kadel* reference would render *Gupta* unsatisfactory for its intended purpose.

The *Gupta* reference is directed towards a user interface to view and create annotations. (*Gupta*, Abstract) *Kadel* on the other hand is directed towards a framework to develop data source components independently of data consumer components. (*Kadel*, abstract) One purpose of *Kadel* is "to provide a framework that allows information handling software to adapt to new data types and formats of information." (*Kadel*, Paragraph 71).

Gupta states that the annotations are managed by an annotation server and the annotations correspond to streaming media available from a media server. (*Gupta*, Column: 4, Lines: 5-7). *Gupta* also gives examples of the media that may be annotated. (*Gupta*, Column: 3, Lines: 39-42). For example, *Gupta* specifically states that media types may consist of audio, video, and graphical media streams. (*Gupta*, Column: 3, Lines: 39-42).

On the other hand *Kadel* states that "image and word processing applications are not examples of what we term information-handling applications." (*Kadel*, Paragraph 74). Furthermore, *Kadel* states "structured information in bulk form does not include plain text or specific electronic media files such as MP3 files." (*Kadel*, Paragraph 74).

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Thus, *Kadel* does not envision providing a framework that works with image applications or one that works with audio (MP3) files. Thus, the types of files which *Kadel* specifically excludes are the types of files that *Gupta* specifically includes. Therefore, the *Kadel* teaches away from the prior art reference of *Gupta*, and would render *Gupta* unsatisfactory for its intended purpose. Thus, there is not a suggestion or a motivation to combine the references.

With regards to the third criteria, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The Examiner argues that the references do teach or suggest all of the claim limitations of claim 28. Respectfully, the Examiner errs. *Gupta* and *Kadel* fail to teach at least the claim 28 limitation of "a set of annotation structures" as discussed earlier with respect to the Examiner's 35 USC §102(e) rejections. Therefore, claim 28 and its dependents are believed to be allowable and allowance of the claims is respectfully requested.

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Conclusion

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted, and


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Annotated Sheet Showing Changes

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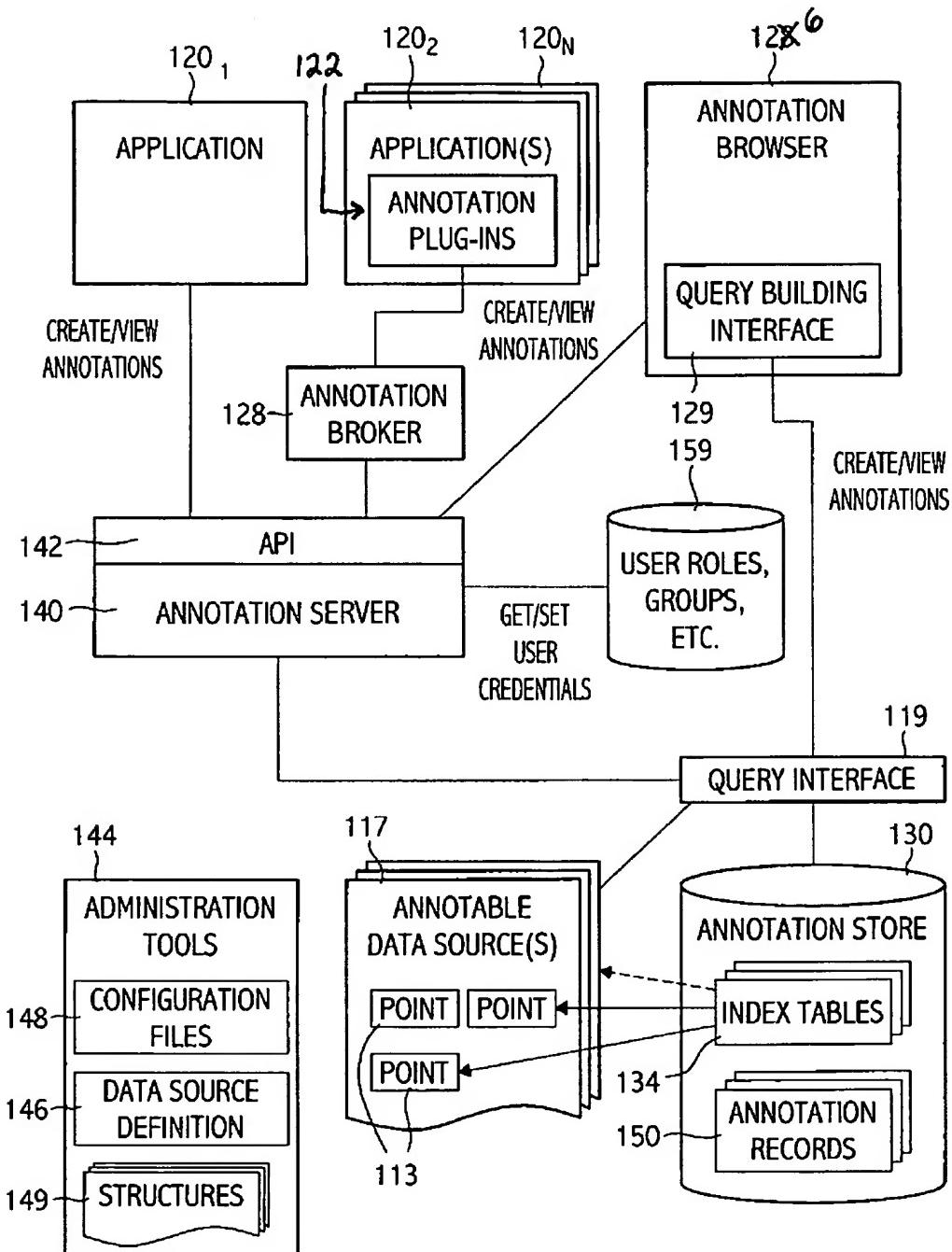


FIG. 3A

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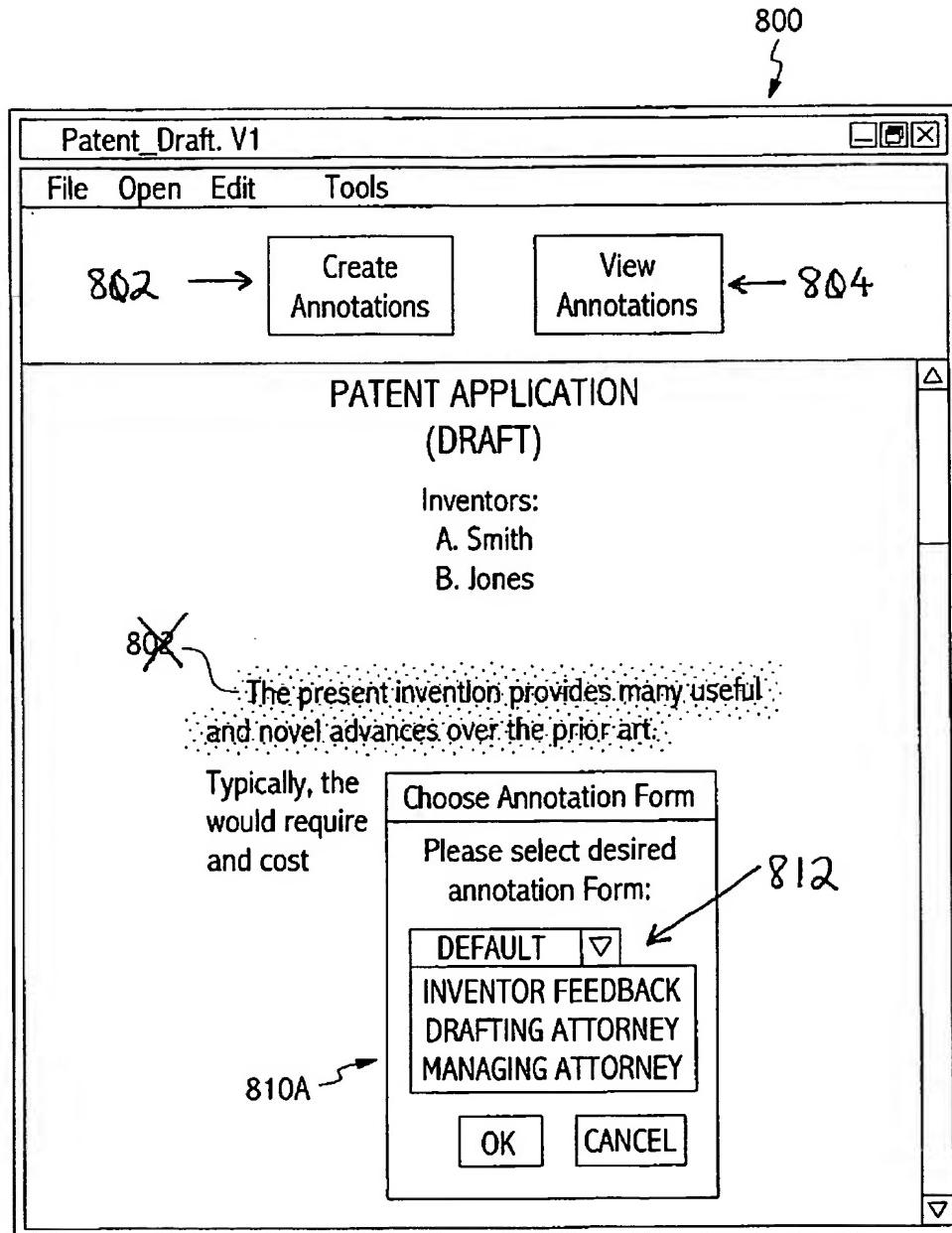


FIG. 8A